

Appl. No. : 10/063,578
Filed : May 3, 2002

REMARKS

Sequence Listing

The Examiner requested that Applicants provide a paper copy of the Sequence Listing with the present response. Applicants provide the requested paper copy of the Sequence Listing herewith and have made the appropriate amendment to the specification.

Priority

The Examiner noted that the priority statement on page 2 of the specification states that Application Serial No. 10/006867 is a continuation of PCT/US00/23328. According to the Examiner, the continuity data for Application Serial No. 10/006867 indicates that it is a continuation-in-part of PCT/US00/23328. Applicants note that, in fact, Application Serial No. 10/006867 is a continuation of PCT/US00/23328 as both applications have the same specification.

The Examiner also notes that the priority statement in the present application states that PCT/US00/23328 is continuation-in-part of Application Serial No. 09/380137 and that Application Serial No. 09/380137 was never granted a filing date or a 371(c) date. Applicants have amended the specification to delete the priority claim to Application Serial No. 09/380137.

Withdrawn Rejections

Applicants acknowledge the withdrawal of the previous utility and enablement rejections in view of the PTO's recognition that the data in Example 18 support the differential expression of the PRO1158 polypeptide.

Correction of Inventorship Under 37 CFR §1.48(b)

Applicants request that Paul J. Godowski be deleted as an inventor, as his invention is no longer being claimed as a result of prosecution. The fee as set forth in §1.17(i) is submitted herewith.

Rejections Under 35 U.S.C. §102(a)

Claims 1-5 were rejected on the assertion that they are anticipated by Baker et al., WO 00/63088. Applicant notes that there appears to be a typographical error in the publication

Appl. No. : **10/063,578**
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number cited by the Examiner. Applicants assume that the Examiner intended to refer to the Baker application published as WO 99/63088.

The Examiner asserts that Figure 270 of Baker et al. discloses a PRO1158 sequence which is identical to SEQ ID NO: 68 of the present application. M.P.E.P. §2132.01 provides that Applicants disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. §102(a). Under M.P.E.P. §2132.01, where the applicant is one of the coauthors of a publication cited against the application, the rejection can be overcome by submission of a specific Declaration by the applicant establishing that the reference is describing the applicants own work.

Applicants submit herewith the Declaration of William Wood under 37 C.F.R. § 1.132. In the Declaration, William Wood states that Figure 270 of WO 99/63088 is a publication of Applicants' own invention. Applicants respectfully submit that in view of the foregoing, the sequence of Figure 270 of Baker et al. cannot be considered to be "known or used by others in this country or patent or described in a printed publication in this or a foreign country before the invention thereof by the applicant for a patent." Consequently, the sequence disclosed in the Baker reference is not prior art against the present application under 35 U.S.C. § 102(a)

Rejections Under 35 U.S.C. §103

Claims 1-5 were rejected under 35 USC §103(a) on the assertion that they are obvious over Strausberg, NCBI Accession No. BE531149 created August 7, 2000, in view of U.S. Patent No. 6,262,234. The Examiner asserts that Strausberg et al. teaches a nucleic acid sequence that encodes a polypeptide which is 100% identical to SEQ ID NO: 68.

Applicants note that Strausberg discloses a raw nucleic acid sequence obtained from adenocarcinoma but does not disclose any additional information relating to the sequence such as homology to other known sequences or information relating to the differential expression pattern of the nucleic acid.

The well-established "Stempel Doctrine" stands for the proposition that a patent applicant can effectively swear back of and remove a cited prior art reference by showing that he or she made that portion of the claimed invention that is disclosed in the prior art reference. (*In re Stempel*, 113 USPQ 77 (CCPA 1957)). In other words, a patent applicant need not demonstrate

Appl. No. : 10/063,578
Filed : May 3, 2002

that he or she made the entire claimed invention in order to remove a cited prior art reference. He or she need only demonstrate prior possession of that portion of his or her claimed invention that is disclosed in the prior art reference and nothing more.

The Stempel Doctrine was extended to cases where a reference disclosed the claimed compound but failed to disclose a sufficient utility for it in *In re Moore*, 170 USPQ 260 (CCPA 1971). More specifically, the patent applicant (Moore) claimed a specific chemical compound called PFDC. In support of a rejection of the claim under 35 U.S.C. § 102, the Examiner cited a reference which disclosed the claimed PFDC compound, but did not disclose a utility for that compound. Applicant Moore filed a declaration under 37 C.F.R. § 1.131 demonstrating that he had made the PFDC compound before the effective date of the cited prior art reference, even though he had not yet established a utility for that compound. The lower court found the 131 declaration ineffective to swear back of and remove the cited reference, reasoning that since Moore had not established a utility for the PFDC compound prior to the effective date of the cited prior art reference, he had not yet completed his “invention”.

On appeal, however, the CCPA reversed the lower court decision and indicated that the 131 declaration filed by Moore was sufficient to remove the cited reference. The CCPA relied on the established Stempel Doctrine to support its decision, stating:

An applicant need not be required to show [in a declaration under 37 C.F.R. § 1.131] any more acts with regard to the subject matter claimed that can be carried out by one of ordinary skill in the pertinent art following the description contained in the reference...the determination of a practical utility when one is not obvious need not have been accomplished prior to the date of a reference unless the reference also teaches how to use the compound it describes. (*Id.* at 267, emphasis added).

Thus, *In re Moore* confirms the Stempel Doctrine, holding that in order to effectively remove a cited reference with a declaration under 37 C.F.R. § 1.131, an applicant need only show that portion of his or her claimed invention that appears in the cited reference. Moreover, *In re Moore* stands for the proposition that when a cited reference discloses a claimed chemical compound either absent a utility or with a utility that is different from the one appearing in the claims at issue, a patent applicant can effectively swear back of that reference by simply showing prior possession of the claimed chemical compound. In other words, under this scenario, the

Appl. No. : 10/063,578
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patent applicant need not demonstrate that he or she had discovered a patentable utility for the claimed chemical compound prior to the effective date of the prior art reference.

While these cases discuss the ability to effectively swear back of the cited reference by way of a 131 declaration, Applicants submit that the same reasoning applies here, where the applicants filed patent applications disclosing the polypeptide of SEQ ID NO: 68 prior to the publication of the cited reference. In particular, U.S. Patent Application 09/380137 filed 8/25/1999, PCT/US99/12252, filed 6/2/1999 and U.S. Provisional Patent Application 60/090246 filed 6/22/1998 disclose the polypeptide of SEQ ID NO: 68. Because Applicants demonstrated, by means of the disclosure in their provisional application filed June 22, 1998, that they were in possession of so much of the claimed invention as is disclosed in BE531149 prior to the publication dates of this reference, Applicants respectfully submit that this reference is not available as prior art.

Accordingly, Applicants respectfully request that the rejections under 35 USC §103 be withdrawn.

CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Jun 30, 2007

By: Daniel Hart
Daniel Hart
Registration No. 40,637
Attorney of Record
Customer No. 30,313
(619) 235-8550

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